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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,013	11/04/2003	Rory A.J. Curtis	MPI99-025CP2DV1M	7317

30405 7590 08/08/2006

MILLENNIUM PHARMACEUTICALS, INC.
40 Landsdowne Street
CAMBRIDGE, MA 02139

EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,013

Applicant(s)

CURTIS ET AL.

Examiner

Marianne P. Allen

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 40-60 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-39 have been cancelled and claims 40-60 have been newly introduced.

Priority

It is noted that the oath claims benefit to application PCT/US00/05409 under 35 USC 119. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority for PCT/US00/05409 under 35 USC 119, a certified copy of the foreign application must be submitted.

Applicant is requested to update the status (i.e. abandoned) of the applications referenced in the first sentence(s) of the specification following the title.

Information Disclosure Statement

Applicant is advised that most of the references have been lined through on the IDS submitted 11/4/03 because these references were not found in the parent application files. If applicant would like them to be considered, they are requested to submit copies of the references and a new PTO 1449 Form.

Claim Rejections - 35 USC § 112

Claims 40-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The preliminary amendment filed 11/4/03 amends the specification in multiple places to include reference to ATCC Deposit No. PTA-1640. The enablement of claims 40-60 requires availability of ATCC Patent Deposit Number PTA-1640 as this material is recited, and thus is required, by the claims. Accordingly, it is deemed that a deposit of this material should have been made in accordance with MPEP 2402. In order to certify that the deposit meets the criteria set forth in MPEP 2402, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number. Applicant is advised that the Patent Office accepts Budapest approved deposits, as long as assurance is provided that the deposited materials will be made irrevocably available with no restrictions upon issuance of a patent.

Applicant has not submitted any documentation in this application supporting these changes to the specification. Applicant may submit copies of any supporting documentation from a parent application to complete this file.

Claims 40-60 are not originally filed claims. Basis is stated to be on pages 7, 12, 14, 23, 50, 53, and 55. However, many of the limitations of the claims are not seen at these pages. For example, the concept of "contacting a sample comprising a polypeptide" is not seen. (See for example, claim 40, 47, and 54.) A method for identifying a compound using "a polypeptide comprising a fragment of at least 15 contiguous amino acids" is not seen. (See for example, claim 54.) A method for identifying a compound using a polypeptide with the limitations of claims 41, 48, or 55 is not seen. The generic limitation of claim 45, 52, or 59 for any activity of

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the polypeptide is not seen. Basis for the particular activities in claims 46, 63, and 60 is not seen.

Basis for the general concept of “immunoassay” in claims 44, 51, and 58 is not seen.

In addition, 15 contiguous amino acids (the smallest embodiment as set forth in claim 54) would not be expected to have potassium channel activity.

In addition, claim 45 recites that the binding of the test compound to the polypeptide is detected by an assay for an activity of the polypeptide. The only activities that appears to be disclosed are potassium channel activity as recited in claim 1 as reflected in the assays recited in claim 46. No other activities or ways of determining activity appear to be set forth. See also claims 52-53.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roberds et al. (US 2003/0064433) and Yue et al. (US 2004/0224911) are not prior art against the instant application.

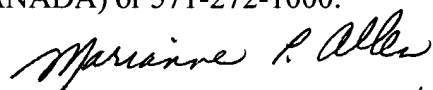
Roberds et al. discloses SEQ ID NOS: 75 and 36 which have greater than 95% identity to SEQ ID NOS: 11 and 12 of the instant application.

Yue et al. discloses SEQ ID NOS: 9 and 39 which have greater than 95% identity to SEQ ID NOS: 11 and 12 of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Marianne P. Allen
Primary Examiner
Art Unit 1647
8/4/06

mpa